

## **Remarks**

### **1. Summary of the Office Action**

In the office action mailed December 11, 2007, the Examiner rejected 1-3, 5-7, 12, 14-15, and 20-21 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2004/0228292 (Edwards), the Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being allegedly obvious over Edwards in view of U.S. Patent No. 6,501,740 (Sun), and the Examiner rejected claims rejections of claims 8-11, 13, 16-19, and 22-23 under 35 U.S.C. § 103(a) as being allegedly obvious over Edwards in view of U.S. Patent Application Pub. No. 2004/0190489 (Palacz).

### **2. Improper Finality of the Office Action**

Applicant submits that the Examiner erred in designating the office action as final. On October 23, 2007, Applicant filed an RCE, in which Applicant amended the claims to further distinguish over the cited art, and in which Applicant set forth new arguments. In the Advisory Action mailed October 10, 2007, the Examiner admitted that the amendments changed the scope of the independent claims and thus required further consideration. Given the new arguments and new claim language submitted with an RCE, it was improper for the Examiner to designate the latest office action as final; the Examiner should have designated the office action as non-final. Therefore, Applicant respectfully requests withdrawal of the finality of the office action.

### **3. Status of the Claims**

Applicant has amended claim 1 to include the limitations of claim 4 (which depended directly from claim 1) (and to add the label "particular" before the word "mode"), and Applicant has cancelled claim 4. Further, Applicant has amended claims 2-3, 5, 7-8, and 11-

14 for consistency with the amendments of claim 1. Applicant has cancelled claims 15-19 and 21-23. Now pending are claims 1-3 and 5-14, of which claim 1 is independent.

By making these amendments, Applicant does not acquiesce in the Examiner's rejections or assertions about the teachings of the prior art. Rather, Applicant has made these amendments in order to expedite prosecution.

#### **4. Response to Rejections**

Of the pending claims, claim 1 is independent and effectively recites the subject matter that was recited by claim 4. As noted above, the Examiner rejected claim 4 as being allegedly obvious over Edwards in view of Sun. Applicant submits that the Examiner's rejection of claim 4 was improper, however, and that claim 1 should therefore be allowed.

Claim 4 recited (and claim 1 now recites) that each user station is (i) a half-duplex capable station or (ii) a half-duplex and full-duplex capable station, and that, during a real-time media session between a plurality of user stations via a communication server, the communication server detects that a half-duplex capable station joins the session and that the communication server responsively directs each other participating station to operate in the half-duplex mode.

This functionality is not disclosed or suggested by Edwards or Sun or by the combination of Edwards and Sun, and the functionality does not logically follow from the limited teachings of Edwards and Sun. Thus, *prima facie* obviousness of the claimed invention over Edwards in view of Sun does not exist.

In rejecting claim 4, the Examiner admitted that Edwards does not specifically disclose the limitation of during the real-time media session, the communication server detecting that a half-duplex station joins the session and responsively directing each other

participating station to operate in the half-duplex mode. The Examiner then proceeded to identify certain concepts disclosed by Edwards and Sun, but those concepts clearly would not reasonably lead one of ordinary skill in the art to achieve the invention recited by claim 4 (now claim 1).

First, the Examiner pointed out that Edwards discloses that users of mobile stations may operate in a full-duplex mode or half-duplex mode. Edwards' disclosure that users may operate in full-duplex or half-duplex mode clearly does not lead to the invention of claim 4 (now claim 1). The ability of a user to operate in full-duplex or half-duplex would not logically lead one to achieve the claimed functionality of the communication server detecting that a half-duplex station joins the session and responsively directing each other participating station to operate in the half-duplex mode. Indeed, Edwards accommodates concurrent use of both half-duplex and full-duplex communication. (*See, e.g.*, Edwards at 0013.)

Second, the Examiner pointed out that Edwards discloses that users of mobile stations may terminate the communication if a device leaves the coverage area of the communication system. This teaching also does not logically lead to the functionality of claim 4 (now claim 1). The fact that a user can lose coverage and drop out of a communication session clearly does not suggest or reasonably lead to a communication server detecting that a half-duplex station joins the session and responsively directing each other participating station to operate in the half-duplex mode.

Third, the Examiner pointed out that Sun discloses the concept of a user joining an existing conference by pressing a join button. Clearly, the mere concept of a user being able to join an existing conference does not reasonably or logically lead to the claim function of a

communication server detecting that a half-duplex station joins the session and responsively directing each other participating station to operate in the half-duplex mode.

Fourth, the Examiner pointed out that Sun also discloses the concept of conferences being operable in either a full duplex mode or a half duplex mode. But again, the mere ability to conduct a conference in one of these modes does not reasonably or logically lead to the claim function of a communication server detecting that a half-duplex station joins the session and responsively directing each other participating station to operate in the half-duplex mode.

After noting these teachings of Edwards and Sun, the Examiner assertion that it would have been obvious to incorporate Sun's teaching into Edward's teaching:

It would have thus been obvious to a person skilled in the art at the time the invention was made to incorporate the concept of having the capability of joining an existing conference as disclosed by Sun into the method for providing full duplex and half duplex dispatch calls, in order to efficiently ensure that users of mobile devices are capable of joining conference calls that are held in half duplex or full duplex modes.

This assertion by the Examiner, however, does not support a conclusion that claim 4 (now claim 1) is obvious under 35 U.S.C. § 103.

The Examiner has merely concluded that it would be obvious to combine the disclosure of Sun into the disclosure of Edwards. However, combining the disclosure of Sun into the disclosure of Edwards would not reasonably or logically lead a person of ordinary skill in the art to achieve the invention of claim 4 (now claim 1). Rather, as the Examiner noted, the combination would put into Edwards the functionality of having a user join an existing conference that can be half-duplex or full-duplex. Yet the mere concept of a user joining an existing conference that can be half-duplex or full-duplex clearly does not amount

to a communication server detecting that a half-duplex station joins the session and responsively directing each other participating station to operate in the half-duplex mode.

Because the teachings of Edwards and Sun would not reasonably lead to the invention recited in claim 4, and because the Examiner did not establish objective rationale as to why one would achieve the invention of claim 4 without the benefit of first reading the claim itself, Applicant submits that the Examiner did not establish *prima facie* obviousness of claim 4. Because claim 1 recites the subject matter of claim 4, Applicant submits that *prima facie* obviousness of claim 1 over Edwards in view of Sun does not exist. Therefore, Applicant submits that claim 1 is allowable. Further, without conceding any of the Examiner's assertions, Applicant submits that dependent claims 2-3 and 5-14 are allowable as well for at least the reason that they depend from allowable claim 1.

## **5. Conclusion**

For the foregoing reasons, Applicant respectfully requests favorable reconsideration and allowance of all of the pending claims.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

**McDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP**

Dated: February 8, 2008

By: /Lawrence H. Aaronson/  
Lawrence H. Aaronson  
Reg. No. 35,818